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09/392,585	09/09/1999	THIERRY DESLANDES	Q055716	1444

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SUGHRUE MION ZINN MACPEAK & SEAS
2100 PENNSYLVANIA AVENUE NW
SUITE 800
WASHINGTON, DC 200373202

EXAMINER

VAUGHN JR, WILLIAM C

ART UNIT	PAPER NUMBER
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2143

DATE MAILED: 01/16/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/392,585

Applicant(s)

DESLANDES ET AL.

Examiner

William C. Vaughn, Jr.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 October 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6-11 and 13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-11 and 13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

WCV

DETAILED ACTION

1. This Action is in response to the Amendment and Reply received on 27 October 2003.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. **Claims 1-4, 6-11 and 13** are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. Applicant's specification lacks the proper teachings that is critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). Applicant claims acquires at the supervision terminal a current invoicing index indicative of the at least one of the isolated franking machines and receives a code of authorization to frank in order to validate the subsequent frankings for the at least one of the isolated franking machines. Applicant states on page 4 of the specification that "traditional machines 30, 32 ... isolated from this network and operate independently. How does the information exchange between the traditional machines and the supervision terminal occur, when the traditional machines are isolated from the network. It does not even state within the specification that the machines are electrically isolated as the applicant claims. It only states that they are isolated from the network (see page 4 of Applicant's specification). Thus, details essential to the making of applicant's invention are not set forth within the specification. Furthermore, it would require undue experimentation for one of ordinary skill in the networking art at the time the invention was made to determine the details of how to acquires at the supervision terminal a current invoicing index

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indicative of the at least one of the isolated franking machines and receives a code of authorization to frank in order to validate the subsequent frankings for the at least one of the isolated franking machines.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. **Claims 1-4, 6-11, and 13** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. In claim 1, the recitation “at least one supervision terminal from which the **plurality of franking machines is independent**”, is unclear and ambiguous. The term independent may have many meanings. For example, independent could mean having multiple servers (i.e., S_1, S_2, S_3, S_n) and multiple franking machines (C_1, C_2, C_3, C_n), whereas S_2 is independent of C_1 . Thus, it is clear that the Applicant will need to state more distinctly within the claim language the meaning of a plurality of franking machines being independent from at least one supervision terminal.

b. In claim 1, the recitation “receives a code of authorization to frank in order to validate the subsequent frankings of the at least one of the isolated franking machines” is also unclear. It is unclear as to how the code of authorization is received or has been received from the at least one of the isolated franking machines. Also, is this authorization done for each franking operation?

c. In claim 1, the recitation, "displaying, at the supervision terminal (1) a list of the plurality of franking machines" is unclear as to whether the list of the plurality of franking machines includes the at least one isolated franking machines.

d. In claim 1, the recitation, "(2) for each one of the plurality of franking machines, a last invoicing index validated by the management server", is unclear as to the state in which the last invoicing index being validated by the management server is to be used for the authorization code. How does the tie in with the code of authorization?

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. **Claims 1, 4, 7-11 and 13** are rejected under 35 U.S.C. 103(a) as being unpatentable over Le Carpentier, U.S. Patent No. 4,752,950 in view of what was well known in the art (well known) in further view of Kim et al. (Kim), U.S. Patent No. 5,224,046.

Regarding **claim 1**, Le Carpentier discloses the invention substantially as claimed. Le Carpentier discloses *a process for monitoring the consumption of a plurality of franking machines* (item 1), [see Le Carpentier, Col. 2, lines 54-58 and Col. 6, lines 4-10] *through a public communication network* [see Le Carpentier, Figure 1, item 3, Abstract, Col. 1, lines 54-67, Col. 2, lines 1-2], *and at least one of the franking machines being in communication with the public communications network* [see Le Carpentier, Col. 2, lines 25-66] *the process comprising the steps of: first*

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establishing a link with a management server (item 2) through the public communications network in accordance with a protocol of communication, via at least one supervision terminal (item 4) from which the plurality of franking machine is independent (The Examiner takes Official Notice (see MPEP 2144.03), that this limitation was well known in the networking art at the time the invention was made. Thus, it would have been obvious to one of ordinary skill in the networking art at the time the invention was made for a plurality of franking machines to be independent from at least one supervision terminal. Since, Le Carpentier does teach local station 4X being independent from franking machine 1G), [see Le Carpentier, Figure 1], [see also prior art of record, Sneeringer, U.S. Patent No. 6,618,709, where it clearly discloses in Figure 4, intelligent meter #m+1 being independent of network server application server as well as being independent of customer pc [see Sneeringer, Figure 4, items 10, 12, 14, 20, 22, 24, 26, 120, 200, 110] *and subsequently proceeding with an exchange of data between the supervision terminal and the management server during which a user (1) acquires at the supervision terminal a current invoicing indicative of franking machines*[see Le Carpentier, Col. 2, lines 61-65, Col. 8, lines 12-67 and Col. 9, lines 1-26] and (2) *receives a code of authorization to frank in order to validate the subsequent frankings of the franking machine* [see Le Carpentier, Col. 8, lines 50-67 and Col. 9, line 13]. However, Le Carpentier does not explicitly disclose at least one of the franking machines being electrically isolated from the public communications network. Also, Le Carpentier does not explicitly disclose the current invoicing index indicative of the at least one of the isolated franking machines and receives a code of authorization to frank in order to validate the subsequent frankings of the at least one of the isolated machines. Furthermore, Le Carpentier does not explicitly disclose displaying at the supervision terminal (1) a list of the plurality of

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franking machines, and (2) for each one of the plurality of franking machines, a last invoicing index validated by the management server. An ordinary artisan in the art at the time the invention was made, would have been motivated to look to replacing the inconvenient and time-consuming procedures of human intervention with a more automated and less inconvenient system [see Le Carpentier, Col. 1, lines 45-50].

8. In the same field of endeavor, Kim discloses (e.g., a system for recharging a plurality of postage meters). Kim discloses *at least one of the franking machines being electrically isolated from the public communications network and wherein said data exchange further comprises: the current invoicing index indicative of the at least one of the isolated franking machines and receives a code of authorization to frank in order to validate the subsequent frankings of the at least one of the isolated machines* [see Kim, Col. 8, lines 53-67 *displaying, at the supervision terminal (1) a list of the plurality of franking machines, and (2) for each one of the plurality of franking machines, a last invoicing index validated by the management server* (Kim teaches that system determines if a meter is selected through the network controller. If the selected meter is not connected (isolated meter), the system displays a request for manual input of the access code and waits for that input. Kim also teaches that the system displays options for meter list maintenance), [see Kim, Col. 3, lines 14-40, Col. 5, lines 46-67, Col. 6, lines 1-67, Col. 7, lines 1-67, and Col. 8, lines 1-68].

9. Accordingly, it would have been obvious to one of ordinary skill in the networking at the time the invention was made to have incorporated Kim's teachings of a system for recharging a plurality of postage meters with the teachings of Le Carpentier and well known, for the purpose of providing a system that is compatible with existing postage meters (i.e., mechanical and

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electrical mechanical postage meters) without the necessity of obtaining approval from a postal service as well as providing a system which is capable of obtaining a recharge code for a plurality of selected postage meters [see Kim, Col. 3, lines 1-22]. By this rationale **claim 1** is rejected.

10. Regarding **claim 4**, Le Carpentier-well known and Kim further discloses *wherein said step of exchange further comprises the user entering into the supervision terminal all identifier including at least one of a password and a personal identification number* [see Kim, Col. 5, lines 8-10]. By this rationale **claim 4** is rejected.

11. Regarding **claim 7**, Le Carpentier-well known and Kim further discloses *wherein the code of authorization to frank comprises information indicative of one of (1) an authorized maximum amount of credit*, [see Kim, Col. 8, lines 53-67] *(2) an authorized maximum amount of consumption* [see Kim, Col. 8, lines 53-67], *(3) a period of franking* [see Kim, Col. 5, lines 58-67]. By this rationale **claim 7** is rejected.

12. Regarding **claim 8**, Le Carpentier-well known and Kim further discloses *wherein the code of authorization to frank is obtained by calculation from one of the current invoicing index* [see Kim, Col. 6, lines 3-27] *and a serial number of a printing head* [see Le Carpentier, Col. 4, lines 41-49]. By this rationale **claim 8** is rejected.

13. Regarding **claim 9**, Le Carpentier-well known and Kim further discloses *wherein the code of authorization to frank is obtained by calculation from a current data* [see Kim, Col. 6, lines 3-27]. By this rationale **claim 9** is rejected.

14. Regarding **claim 10**, Le Carpentier-well known and Kim further discloses *wherein the code of authorization to frank is obtained by calculation from information indicative of (1) a*

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maximum amount of credit, (2) a maximum amount of authorized consumption, and (3) an authorized period of franking [see Kim, Col. 8, lines 53-67]. By this rationale **claim 10** is rejected.

15. Regarding **claim 11**, Le Carpentier-well known and Kim further discloses *wherein the protocol of communication used, for establishing a link the management server is a protocol of telephonic communication of a vocal synthesis* [see Le Carpentier, Col. 2, lines 33-44]. By this rationale **claim 11** is rejected.

16. Regarding **claim 13**, Le Carpentier-well known and Kim further discloses *wherein the steps of data exchange further comprises, at the supervision terminal, a current invoicing index indicative of the isolated franking machine and receiving, from the management server, a code of authorization to frank in order to validate the subsequent franking of the isolated franking machine* [see Kim, Col. 5, lines 46-68 and Col. 6, lines 1-27]. By this rationale **claim 13** is rejected.

Claim Rejections - 35 USC § 103

17. **Claims 2 and 3** are rejected under 35 U.S.C. 103(a) as being unpatentable over Le Carpentier-well known and Kim as applied to **claims 1, 4, 7-11 and 13** above, and further in view of Gerszberg et al. (Gerszberg), U.S. Patent No. 6,359,881.

18. Regarding **claim 2**, Le Carpentier-Kim further discloses the invention substantially as claimed. Le Carpentier-Kim suggests the use of protocols [see Le Carpentier, Col. 5, lines 54-59]. However, Le Carpentier-well known and Kim does not explicitly disclose of wherein the

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protocol of communication used for establishing a link with the management server is a Videotex protocol, such as a teletel protocol.

19. In the same field of endeavor, Gerszberg discloses (e.g., a system that allows for increased services to an end users by way of a video phone and other devices). Gerszberg discloses of *wherein the protocol of communication used for establishing a link with the management server is a Videotex protocol, such as a teletel protocol* [see Gerszberg, Col. 2, lines 19-35, Col. 8, lines 53-67, Col. 9, lines 1-16, Col. 12, lines 57-65].

20. Accordingly, it would have been obvious to one of ordinary skill in the networking art at the time the invention was made to have incorporated Gerszberg's teachings of a system that allows for increased services to an end users by way of a video phone and other devices with the teachings of Le Carpentier-well known and Kim, for the purpose of providing an improved network for interexchange companies to access different lines or alternate lines, which would allow for the utilization of video phones and other devices in order to provide additional services to an end user [see Gerszberg, Col. 2, lines 19-33]. By this rationale **claim 2** is rejected.

21. Regarding **claim 3**, Le Carpentier-well known, Kim and Gerszberg further discloses *wherein the protocol of communication used for establishing a link with the management server is a protocol of TCP/IP type* [see Gerszberg, Col. 8, lines 20-24]. By this rationale **claim 3** is rejected.

Claim Rejections - 35 USC § 103

22. **Claim 6** is rejected under 35 U.S.C. 103(a) as being unpatentable over Le Carpentier-well known and Kim as applied to **claims 1, 4 and 7-11 and 13** above, and further in view of Breault et al. (Breault), U.S. Patent No. 4,908,770.

23. Regarding **claim 6**, Le Carpentier-Kim discloses the invention substantially as claimed. Le Carpentier-well known and Kim further suggest displaying data [see Kim, Col. 3, lines 22-33]. However, Le Carpentier-well known and Kim does not explicitly disclose of wherein said step of data exchange further comprises displaying, at the supervision terminal, one of a selectable plurality of tables and statistics in graph form relating to the list of printing heads.

24. In the same field of endeavor, Breault discloses (e.g., a mail management system). Breault discloses *wherein said step of data exchange further comprises displaying, at the supervision terminal, one of a selectable plurality of tables and statistics in graph form relating to the list of printing heads* [see Breault, Col. 5, lines 40-68 and Col. 6, lines 1-50].

25. Accordingly, it would have been obvious to one of ordinary skill in the networking art at the time the invention was made to have incorporated Breault's teachings of a mail management system with the teachings of Le Carpentier-well known and Kim, for the purpose of providing a method and apparatus that receives and validates client account identification codes and which also allows for the dispensing of postage event when the host system is inoperative [see Breault, Col. 2, lines 33-40]. By this rationale **claim 6** is rejected.

Response to Arguments

26. Applicant's arguments filed on 27 October 2003 have been carefully considered but they are not deemed fully persuasive. However, because there exists the likelihood of future

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presentation of this argument, the Examiner thinks that it is prudent to address applicants' main points of contention.

- a. Applicant argues that Le Carpentier "actually teaches away from the present invention as indicated by the Examiner".
- b. Applicant asserts that one of ordinary skill in the art would not have been motivated to combine Le Carpentier and Kim.
- c. Applicant also argues that the rejection of these claims is improper because of impermissible hindsight.
- d. Applicant also argues "the Examiner does not even address the "independent" feature when he further states that Le Carpentier-Kim does teach a plurality of franking machines (i.e., meters) that are separate from the local states".

27. As to "Point A", it is the position of the Examiner that the Applicant has incorrectly stated that the Examiner has indicated that Le Carpentier teaches away from the present invention. As indicated in the previous rejection (see paper 27), it was and still is the position of the Examiner that Le Carpentier in combination with Kim teaches Applicant's claimed invention.

28. As to "Point B" to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir.

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1992). In this case, of Le Carpentier looking to replace inconvenient and time consuming procedures which require human intervention with procedures which are automated and less inconvenient, one would have been led to Kim, which allows for isolated machines to be reset as well as those that are connected to a management machine.

29. Also, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). Thus, it quite apparent to the Examiner that obviousness has been shown as well as the claimed invention being suggested in the references used within the rejection.

30. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

31. Again, it is the Examiner's position that Applicant has not yet submitted claims drawn to limitations, which define the operation and apparatus of Applicant's disclosed invention in manner, which distinguishes over the prior art. As it is Applicant's right to continue to claim as broadly as possible their invention. It is also the Examiner's right to continue to interpret the

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claim language as broadly as possible. It is the Examiner's position that the detailed functionality that allows for Applicant's invention to overcome the prior art used in the rejection, fails to differentiate in detail how these features are unique. As it is extremely well known in the networking art as already shown by Le Carpentier, well known, Kim, Gerszberg, Breault and other prior arts of records disclosed, for the resetting of franking machines both isolated and connected as well as other claimed features of Applicant's invention. Thus, it is clear that Applicant must submit amendments to the claims in order to distinguish over the prior art use in the rejection that discloses different features of Applicant's claim invention.

32. Applicant has had numerous opportunities to amend the claimed subject matter, and has failed to modify the claim language to distinguish over the prior art of record by clarifying or substantially narrowing the claim language. Thus, Applicant apparently intends that a broad interpretation be given to the claims and the Examiner has adopted such in the present and previous Office action rejections. See *In re Prater and Wei*, 162 USPQ 541 (CCPA 1969), and MPEP 2111.

33. Applicant employs broad language, which includes the use of word, and phrases (i.e., independent, isolated), which have broad meanings in the art. In addition, Applicant has not argued any narrower interpretation of the claim language, nor amended the claims significantly enough to construe a narrower meaning to the limitations. As the claims breadth allows multiple interpretations and meanings, which are broader than Applicant's disclosure, the Examiner is forced to interpret the claim limitations as broadly and as reasonably possible, in determining patentability of the disclosed invention. Although the claims are interpreted in light of the

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specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir.1993).

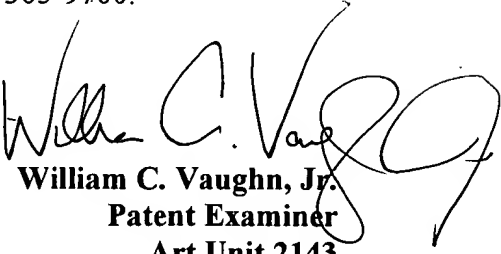
34. Failure for Applicant to significantly narrow definition/scope of the claims and supply arguments commensurate in scope with the claims implies the Applicant intends broad interpretation be given to the claims. The Examiner has interpreted the claims with scope parallel to the Applicant in the response, and reiterates the need for the Applicant to more clearly and distinctly, define the claimed invention.

Conclusion

35. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William C. Vaughn, Jr. whose telephone number is (703) 306-9129. The examiner can normally be reached on 8:00-6:00, 1st and 2nd Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A Wiley can be reached on (703) 308-5221. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-9700.


William C. Vaughn, Jr.
Patent Examiner
Art Unit 2143
05 January 2004